



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/286,530 | 04/05/1999 | L. LAWRENCE CHAPOY | 7651/1239 | 5116 |

757 7590 05/24/2002

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 05/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/286,530

Applicant(s)

CHAPOY ET AL.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17,19-22,24-40 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) 24-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-17,19-22,40 and 42-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3738

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 27, 2002 has been entered.

Election/Restrictions

Claims 24-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6 filed October 23, 2000.

Claim Objection

Claim 44 is objected to because of the following informalities:

In claim 44, line 2, "core" lacks an article such as "the" or "said", and thus, the claim language is grammatically awkward. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-14, 40, 42, and 44-53 rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al (US 6,158,862) in view of Patel (US 5,252,262). Patel et al discloses a monolithically produced intraocular lens with haptics, but fails to disclose a coating on at least the distal portions of the haptics as claimed. However, Patel ('262) teaches that it was known to coat haptics on similar intraocular lenses with polyimide in order prevent dye or pigment leakage; see the whole document, especially Figures 26-27 and column 4, lines 15-57. Hence, it is the Examiner's position that it would have been obvious to clear coat at least the haptics of Patel et al in order to prevent dye leakage which is a concern to Patel et al as well; see column 4, lines 7-14.

With regard to claims 2, 9-14 and 44-53, the product-by-process steps are only given weight to the extent that they affect the final product with little burden on the Examiner's part to meet the claim language; see MPEP 2113, which is incorporated herein by reference thereto. Hence, it is the Examiner's position that the claim product-by-process limitations result in an identical, or alternatively, a substantially identical product to that disclosed by Patel et al as modified by Patel such that the claims are clearly unpatentable thereover.

With regard to claim 6, HEMA is synonymous with 2-hydroxyethylmethacrylate such that the claim language is fully met.

With regard to claim 8, the 550 nm or 400 nm wavelength range is within the UV radiation range, and thus, the dye of Patel et al is a UV absorbing compound to the extent required by the claims; see Patel et al on column 4, lines 1-29.

Art Unit: 3738

With regard to claim 40 and 42-53, the polyimide as claimed is the same material as that set forth by Patel, such that it would inherently have the same fibrosis promotion affect.

Claims 15-17, 19-22, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al and Patel ('262) as applied to claims 1, 2, 4-14, 40, 42, and 44-53 above, and further in view of Cumming (US 5,047,051). Patel et al meets the claim language except for the footplate or an opposing set of plates with grooves as claimed. Cumming, however, teaches that it was known to make haptics into opposing plate or footplate forms with grooves; see the figures and the rest of the document. Hence, it is the Examiner's position that it would have been obvious to make the polyimide coated haptics of Patel et al as modified by Patel into a plate form and to coat the entire haptics thereof with polyamide for the same reasons that Cumming forms his haptics into that form.

Claims 1, 2, 4-7, 9-15, 40, 42, and 44-53 rejected under 35 U.S.C. 103(a) as being unpatentable over Polar (US 4,402,579) in view of Patel (US 5,252,262). Polar discloses a monolithically produced haptic and optic intraocular lens but fails to disclose a polyimide coated haptic as claimed; see the whole document. However, Patel teaches that it was known to coat similar intraocular lens haptics with polyimide or similar polymers. Hence, it would have been obvious to coat at least the haptic of Polar with polyimide in order to improve the surface characteristics thereof as compared to the underlying material as is well known in the art.

Art Unit: 3738

With regard to claims 2, 9-14 and 44-53, the product-by-process steps are only given weight to the extent that they affect the final product with little burden on the Examiner's part to meet the claim language; see MPEP 2113, which is incorporated herein by reference thereto. Hence, it is the Examiner's position that the claim product-by-process limitations result in an identical, or alternatively, a substantially identical product to that disclosed by Polar as modified by Patel such that the claims are clearly unpatentable thereover.

Claims 16, 19-22 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polar and Patel ('262) as applied to claims 1, 2, 4-7, 9-15, 40, 42, and 44-53 above, and further in view of Cumming (US 5,047,051). Polar meets the claim language except for grooves in the plates as claimed. Cumming, however, teaches that it was known to make haptics into opposing plate or footplate forms with grooves; see the figures and the rest of the document. Hence, it is the Examiner's position that it would have been obvious to make the polyimide coated haptics of Polar as modified by Patel into a plate form and to coat the entire haptics thereof with polyamide for the same reasons that Cumming forms his haptics into that form.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure

Art Unit: 3738

outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.


Paul Prebilic
Primary Examiner
Art Unit 3738